



RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
EXAMINING ART GROUP UNIT 1631

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Engelhardt et al.

Serial No.: 08/479,997

Filed: June 7, 1995

For: OLIGO- OR POLYNUCLEOTIDES COMPRISING
PHOSPHATE MOIETY LABELED NUCLEOTIDES
(As Previously Amended)

Group Art Unit: 1631

Exam'r: Ardin H. Marschel, Ph.D.

527 Madison Avenue (9th Fl)
New York, NY 10022-4304
September 3, 2004

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Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT UNDER 37 C.F.R. §1.116
(IN RESPONSE TO THE JULY 14, 2004 OFFICE ACTION)

Dear Sirs:

This is a response (Amendment Under 37 C.F.R. §1.116) to the July 14, 2004 Office Action issued in connection with the above-identified application. A response to the July 14, 2004 Office Action is due by October 14, 2004. Accordingly, this response (Amendment Under 37 C.F.R. §1.116) is being timely filed, and no extension request or extension fees are necessary.

Enz-5(D6)/(C2)

DO NOT ENTER
AM 11-23-04

To The July 14, 2004 Office Action) -- September 3, 2004]

Before addressing the claim amendments and the issues that were discussed at the August 12, 2004 interview, Applicants wish to express their sincere gratitude for the courtesy and time extended by Examiner Ardin H. Marschel, Ph.D., Group Art Unit 1631, to Applicants' representative, Eugene C. Rzucidlo, Esq. of the law firm, Greenberg Traurig, LLP, and their undersigned attorney.

I. Summary of August 12, 2004 PTO Interview

A. Claim 956 (Enablement Rejection, 7/14/04 Office Action, pp. 4-5)

Applicants' undersigned attorney noted at the beginning of the discussion that claim 956 inadvertently recited the term "sugar moiety" instead of "furanosyl moiety." He indicated that claim 956 would be amended to recite "furanosyl moiety" in response to the enablement rejection in the July 14, 2004 Office Action. The Examiner acknowledged Applicants' offer to amend claim 956.

B. Claims 855 et al. (Vagueness and Indefiniteness, 7/14/04 Office Action, p 3)

The matter of claims 855, 886, 920, 955, 987, 1020, 1053, 1086, 1120, 1154, 1188 and 1125 was discussed next. Applicants' attorney indicated that after reviewing the previous office action mailed on November 26, 2003, he took the Examiner's statement on page 3 regarding "further comprising" language as a possible means for amending the rejected claims that would overcome the rejection. The Examiner replied that the rejection required more than the amendment of these claims to recite that the claimed polymer further comprised the recited deoxyribonucleotide or ribonucleotide. In the case of these claims and the rejection, the Examiner said he thought that the rejected dependent claims expanded rather than limited the subject matter of the independent claims. Although no specific language was discussed at the interview, the Examiner did

INT. SUM. OK
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